

In re Patent Application of
Gary L. Martin
Serial No. 09/801,512
Filed March 7, 2001

REMARKS

The Applicant herein responds to the pending Office action and appreciates the Examiner's continuing careful review of the application. In order to further facilitate examination of the application, claims 11-41 have been cancelled without prejudice and four new claims have been added.

The Applicant is also grateful for the Examiner's implicit determination that the claimed invention is novel over the cited art. Accordingly, the Examiner's remaining concerns focus on whether the invention would have been obvious at the time it was made to one skilled in the art. In that regard, pending claims 1-10 stand rejected under Section 103(a) as obvious and unpatentable in view of the cited references. For the reasons set forth below, Applicant respectfully disagrees.

The Claimed Invention is Nonobvious Over the Cited References

The Examiner has rejected independent claims 1 and 10 under Section 103(a) as obvious over the single reference to Chambers (US 5,605,020), Roofing Termination Device.

Applicant has previously pointed out that the Chambers reference describes "a device for terminating a roofing system at the edges thereof." See column 1, lines 1-2. The Chambers invention, thus, is intended to address the problem of ensuring that the periphery of a roof is terminated in a waterproof manner. See column 1, lines 15-47. Chambers continues "[i]t is, therefore, an object of the present invention is [sic] to provide a device for terminating a roofing system at the edges of the roof by sealingly connecting

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the roofing system to the building on which the roofing system is deployed in such a fashion such that the fasteners utilized are situated in a waterproof manner, but are readily accessible, with the exposed vertical surface being able to withstand climatic effects." See column 1, lines 50-58. It is, therefore, clear that the Chambers invention is for a roof.

With the foregoing in mind, Applicant has amended independent claims 1 and 10 to include a recitation which more clearly identifies the present invention as being directed to a covering for the underside of a roof overhang, rather than a covering for finishing the edge of a roof as done by Chambers.

Applicant has also pointed out that independent claims 1 and 10 recite structural features not described or suggested by Chambers. For example, claim 1 recites that the first member has a first soffit portion and a fascia portion, the fascia portion having a distal periphery positioned at an angle relative to the first soffit portion. Chambers does not describe or fairly suggest such a structure, particularly because such structure is not needed in an invention used on the roof of a building. Pending claim 10 recites a first member having a soffit portion and a fascia portion positioned at an angle relative to the soffit portion for fastening to the roof fascia. In addition, claim 10 also recites a second member having a channel. In contrast, in the Chambers invention the same member has both the angled portion and the channel (see Chambers member 10 in FIG. 1; member 12 in FIGS. 2-5; and member 24 in FIG. 7). Thus, Chambers does not describe or suggest the structure recited in pending independent claims 1 or 10.

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For those reasons, Applicant respectfully reasserts that the a *prima facie* case of obviousness has not been established against the pending independent claims. In establishing a *prima facie* case of obviousness, three elements must be shown:

- 1) that the combination (in this case, the single Chambers reference) produces the claimed invention;
- 2) that the prior art contains suggestion or motivation to combine the cited references in such a way as to achieve the claimed invention; and
- 3) that one skilled in the art at the time the invention was made would have reasonably expected the claimed invention to work.

As discussed above in detail, the single Chambers reference does not satisfy at least elements 1) and 2) of the *prima facie* case of obviousness. Accordingly, the obviousness rejection is defective and not proper and Applicant again respectfully requests that the Examiner withdraw the obviousness rejection based on the Chambers reference.

Applicant has further argued that, adaptation of the Chambers invention to the purposes of Applicant's invention would require extensive structural modification of the Chambers device. This modification would destroy the utility of the Chambers device for its originally stated purposes, which is finishing the edges of a roof in a waterproof manner. It is well settled that if use of a reference in an obviousness rejection would require such an extensive modification as to make the invention described in the reference unsuitable for its originally intended purpose, the reference may not be used in the obviousness rejection. Applicant believes such is the case with the Chambers reference.

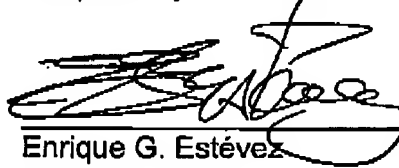
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Conclusion

For the reasons discussed above, Applicant respectfully requests withdrawal of the finality of the Office action, and withdrawal of the claim rejections for obviousness. Applicant submits that independent claims 1 and 10 are, therefore, patentable. In addition, their respective dependent claims, which recite yet further distinguishing features, are also patentable and require no further consideration.

If the further prosecution can be facilitated through a telephone conference between the Examiner and the undersigned, the Examiner is respectfully requested to telephone the undersigned.

Respectfully submitted,




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